

## REMARKS

Reconsideration of the present application is respectfully requested. In response to this Office Action claim 44 has been amended to address the 35 U.S.C. §112(2) rejection, and new claims 53 through 56 have been added to further define the inventions.

Claims 24 through 52 were rejected under 35 U.S.C. §103 as being unpatentable over U. S. Patent No. 5,743,056 to Balla-Goddard. Applicant respectfully traverses the §103 rejection. In reviewing claims for patentability the Manual of Patent Examination instructs that “[t]he examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness.” *See*, MPEP § 2142. “To establish a *prima facie* case of obviousness . . . the prior art reference (or references when combined) must teach or suggest all of the claim limitations.” *See, Id.* The Federal Circuit reiterated in In re Oetiker, 24 USPQ2d 1443, 1446 (Fed. Cir. 1992), that “[t]here must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination” and “[t]hat knowledge can not come from the applicant’s invention itself.” Further, “[a]bsent such suggestion to combine the references, respondents can do no more than piece the invention together using the patented invention as a template. Such hindsight reasoning is impermissible.” Texas Instruments Inc. v. U.S. Int’l Trade Comm’n, 26 USPQ2d 1018, 1029 (Fed. Cir. 1993).

In formulating the §103 rejections of claims 24-52 the Office Action provides that “it would have been obvious to one of ordinary skill in the art at the time the invention was made to choose the desirable thickness to accommodate the opening gap, since it has been held that where the general conditions of the claim are disclosed in the prior art,

discovering the optimum or working ranges involves only routine skill in the art.”

Applicant respectfully disagrees that the general conditions of the claim are in the asserted reference and further disagrees that the present invention only involves selecting an optimum working range. Applicant respectfully reminds the Examiner that:

[i]n a proper obviousness determination, “[w]hether the changes from the prior art are minor . . . the changes must be evaluated in terms of the whole invention, including whether the prior art provides any teaching or suggestion to one of ordinary skill in the art to make the changes that would produce the patentee’s . . . device.’ Northern Telecom, Inc v. Datapoint Corp., 15 USPQ 2d 1321, 1324. This includes what could be characterized as simple changes, as in In re Gordon, 221 USPQ 1125,1127. (Although a prior device could have been turned upside down, that did not make the modification obvious unless the prior art fairly suggested the desirability of turning the device upside down.)

In re Chu, 36 USPQ 2d 1089, 1094 (Fed. Cir. 1995)

In reviewing the ‘056 reference for the required suggestion or motivation to make the modifications proposed in the Office Action , the message from the reference must be more than general guidance or an invitation to explore. In fact there was no suggestion or motivation to modify the ‘056 as set forth in the present application and therefore the Patent Office’s rejection should be construed as making a rejection founded upon being “obvious to try” but that does not make the invention obvious. Ex parte Obukowicz, 27 USPQ2d 1063, 1065 B.P.A.I. 1992 citing In re O’Farrell, 7 USPQ2d 1673, 1681. The “obvious to try” standard does not meet the statutory requirements for a rejection under §103. Withdrawal of the §103 rejections of claims 24-32 is respectfully requested.

Independent claim 24 includes a jamb member adjacent at least one of the struts and wherein the jamb thickness is substantially equal to the sum of said overall panel thickness and said drywall thickness, such that said jamb is substantially flush therewith for said trim piece to be mounted flush across the jamb and drywall without the use of

furring. Upon review of the '056 reference it is respectfully urged that the window sill 206 (Office Action refers to as jamb member) thickness is not substantially equal to the overall panel thickness and the drywall thickness. Upon review of figure 4, it is noted that the cited feature 206 extends well beyond the cement particleboards 56 the foam 58 and the plasterboard 52. Withdrawal of the §103 rejection is respectfully requested for at least this reason.

Independent claim 44 includes that the jamb thickness is adapted to be assembled substantially flush to the panel and drywall without use of furring. Upon review of the '056 reference it is respectfully urged that the window sill 206 (Office Action refers to as jamb member) is not adapted to be assembled substantially flush to the panel and drywall without the use of furring. Upon review of figure 4, it is noted that the cited feature 206 extends well beyond the cement particleboard 56 the foam 58 and the plasterboard 52. Withdrawal of the §103 rejection is respectfully requested for at least this reason.

The law is well settled that in evaluating obviousness type rejections under 35 USC §103 the Patent Office must always consider evidence of secondary considerations when presented. Cable Elec. Prods., Inc. v. Genmark, Inc., 226 USPQ 881, 887 (Fed. Cir. 1985). The Federal Circuit has directed that:

when differences that may appear technologically minor nonetheless have a practical impact, particularly in a crowded field, the decision-maker must consider the obviousness of the new structure in this light. Such objective indicia as commercial success, or filling an existing need, illuminate the technological and commercial environment of the inventor, and aid in understanding the state of the art at the time the invention was made.

Continental Can Co. USA v. Monsanto Co., 20 USPQ 2d 1746, 1752 (Fed. Cir. 1991).

This “evidence of secondary considerations may often be the most probative and cogent evidence in the record. It may often establish that an invention appearing to have been obvious in light of the prior art was not.” Stratoflex, Inc. v. Aeroquip Corp., 218 USPQ 871, 879 (Fed. Cir. 1983).

In responding to this Office Action there is included a Declaration of Mr. Pat Egan. The Declaration provides data supporting the commercial success story regarding products sold by Mr. Egan’s company THERMOCAORE. The Declaration is specific that there are a variety of Pre-Fabricated Panel configurations sold by Mr. Egan’s company and that many of the configurations are covered by claims in the pending application. However, there may also be some Pre-Fabricated Panel configurations that are included in the sales volume, but are not covered by a pending claim.

The present Declaration of Mr. Patrick Egan provides evidence regarding the commercial success of many products associated with the present application. A pair of prior Declarations filed October 21, 2001 by Dave Scheilder and Ray Micham articulate the sentiment of at least two people of experience in the industry. The Declarations provide evidence of the filling of an unmet existing need, and of the commercial success of the present invention.

The Declaration of Mr. Patrick Egan places into evidence facts regarding secondary considerations that must be contemplated when the Patent Office evaluates the obviousness of the claimed invention. As directed by the Court of Appeals for the Federal Circuit this evidence of secondary considerations may often be the most probative and cogent evidence in the record. It may often establish that an invention

appearing to have been obvious in light of the prior art was not. Applicant respectfully requests that all of the §103 rejections be withdrawn in light of the evidence set forth in the present Declaration of Mr. Patrick Egan, the prior Declaration of Mr. Patrick Egan filed February 25, 2003 and the Declarations October 21, 2001 by Dave Scheilder and Ray Micham.

The dependent claims 25-43, 45-52 and 54-55 are deemed to be at least allowable over the prior art as they depend from independent claims that are believed allowable over the prior art.

The Examiner is respectfully requested to reconsider the present application and issue a timely Notice of Allowability for claims 24-56. If any remaining issues could be resolved in a telephone conference, the undersigned would welcome said call.

Respectfully submitted,

By: 

John H. Allie

Reg. No: 39,088

WOODARD EMHARDT NAUGHTON

MORIARTY & McNETT LLP

Bank One Center Tower

111 Monument Circle, Suite 3700

Indianapolis, IN 46204-5137

(317) 634-3456